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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,283	12/22/2005	Hubertus M.R. Cortenraad	US030217	5694

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EXAMINER	
PIZIALI, JEFFREY J	

ART UNIT	PAPER NUMBER
2629	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/562,283	CORTENRAAD ET AL.	
	Examiner	Art Unit	
	Jeff Piziali	2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 December 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-20* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *22 December 2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, **claims 1-7 and 12-20**, drawn to *a system for activating an electronic paint* (claims 1-7), *a system for activating an electronic paint* (claims 12-15), and *an electronic brush* (claims 16-20), classified in class 178, subclass 18.04 (e.g., devices designed to transform an acoustical signals into electrical signals).

Group II, **claims 8-11**, drawn to a *method of activating an electronic paint*, classified in class 345, subclass 177 (e.g., methods of using touch panels including surface acoustical transducers).

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Any international application must relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (see MPEP 1850).

As demonstrated by the "Y" references on the International Search Report, at least one independent claim of the application does not avoid the prior art, therefore, the special technical feature of the application is anticipated by or obvious in view of the prior art.

Consequently, the inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1.

Furthermore, the inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related respectively as product and process of use.

The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product.

See MPEP § 806.05(h).

(1) In the instant case, the process for using the product as claimed (*the method of claims 8-11*) can be practiced with another materially different product (*than the system of claims 1-7*).

For example, the process for using the product as claimed (*the method of claims 8-11*) can be practiced with a product not including at least "***at least two independently movable ultrasonic transducers (20, 22);an electronic brush (30) including an electronic-brush ultrasonic transducer (32); and a controller (40) operably coupled to the two independently movable ultrasonic transducers (20, 22) and the electronic-brush ultrasonic transducer (32), wherein an electronic-brush location with respect to locations of the independently movable ultrasonic transducers (20, 22) is determined from ultrasonic signals communicated between the ultrasonic transducers (20, 22, 32) and received by the controller (40)***" as claimed in independent claim 1 (*lines 2-9*).

In the instant case, the process for using the product as claimed (*the method of claims 8-11*) can be practiced with another materially different product (*than the system of claims 12-15*).

For example, the process for using the product as claimed (*the method of claims 8-11*) can be practiced with a product not including at least "***means for sending ultrasonic signals between a plurality of spaced-apart electronic-paint surface locations and an electronic brush (30); and means for determining an electronic-brush location with respect to electronic-brush surface locations based on the ultrasonic signals***" as claimed in independent claim 12 (*lines 2-5*).

In the instant case, the process for using the product as claimed (*the method of claims 8-11*) can be practiced with another materially different product (*than the brush of claims 16-20*).

For example, the process for using the product as claimed (*the method of claims 8-11*) can be practiced with a product not including at least "***an electronic-brush housing (28); and at least one ultrasonic transducer (32) attached to the electronic-brush housing (28), wherein ultrasonic signals communicated between the electronic-brush ultrasonic transducer (32) and at least two ultrasonic transducers positioned on a surface allow a determination of an electronic-brush location with respect to locations of the ultrasonic transducers positioned on the surface***" as claimed in independent claim 16 (*lines 2-7*).

(2) In the instant case, the product as claimed (*in claims 1-7 and 12-20*) can be used in a materially different process of using that product (*than the method of claims 8-11*).

For example, the product as claimed (*in claims 1-7 and 12-20*) can be used without the method steps of "***positioning a first ultrasonic transducer (20) on a surface (52) containing the electronic paint (50); positioning a second ultrasonic transducer (22) on the surface (52) and spaced apart from the first ultrasonic transducer (20); sending a first ultrasonic signal between the first ultrasonic transducer (20) and an electronic-brush ultrasonic transducer (32) attached to an electronic brush (30); sending a second ultrasonic signal between the second ultrasonic transducer (22) and the electronic-brush ultrasonic transducer (32); and***

determining an electronic-brush location with respect to the first and second ultrasonic transducers (20, 22) based on the first and the second ultrasonic signals," as claimed in independent claim 8 (*line 2-11*).

4. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

(a) the inventions have acquired a separate status in the art in view of their different classification;

(b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;

(c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);

(d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention**.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be

amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder**. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Piziali whose telephone number is (571) 272-7678. The examiner can normally be reached on Monday - Friday (6:30AM - 3PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (571) 272-7681. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeff Piziali/
Primary Examiner, Art Unit 2629
22 July 2008